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REED SMITH LLP				
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PITTSBURGH, PA 15230-0488				
EXAMINER				
ARNETT, NICOLAS ALLEN				
ART UNIT		PAPER NUMBER		
3751				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptoipinbox@reedsmith.com

Office Action Summary

Application No.

10/567,080

Applicant(s)

HASHIBA ET AL.

Examiner

NICOLAS A. ARNETT

Art Unit

3751

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed March 29, 2010 has been entered. Claims 1-8 and 10-22 remain pending.

Drawings

2. The drawings were received on March 29, 2010. These drawings are acceptable.

Specification

3. The objection to the abstract is withdrawn in view of the amendment filed March 29, 2010.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 depends from claim 21 which recites a Markush group limiting the pressing means to those elements recited. However, claim 22 uses the term "comprising" which opens the claim up to elements in addition to the recited spring. It appears that claim 22 should depend from claim 1 rather than claim 21.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 7-8, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,409,137 to Bonomelli (Bonomelli).

Regarding claim 1, Bonomelli discloses a device (batching unit) comprising: a measuring vessel (plate 6) having a first face (upper surface of the plate), a second face parallel to the first (lower surface of plate) and a space (chamber 16) for receiving objects supplied from the first side (Fig. 1); a holder (top plate 5) on the side of the first face (Fig. 1), having a through hole (14) communicable with the space (Fig. 1) and slidable along the first face (col. 4, lines 4-38); a shutter (bottom plate 7) located on the side of the second face (Fig. 1), having a through hole (17) communicable with the space (col. 4, lines 18-38) and movable parallel to the second face (col. 4, lines 4-38); and a pressing means for pressing the holder against the measuring vessel (the weight top plate 5 on slide plate 6; the phrase "means for pressing" invokes 35 U.S.C. 112, sixth paragraph and Applicant's disclosed means for pressing includes springs, hydraulic forces, pneumatic forces, the weight of the holder and/or magnetic forces; see paragraph 32 of Applicant's specification). Regarding the intended use of measuring a hard granular object, it has been held that a recitation with respect to the manner in

which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). The device of Bonomelli could be used for hard granular objects rather than products for infusions.

Regarding claims 7, 8 and 19, Bonomelli discloses the space of the measuring vessel has an opening with an unchamfered edge in both the first face and the second face (see Fig. 1 showing the edges of the opening in the slide plate 6 are unchamfered).

Regarding claim 21, Bonomelli discloses the pressing means is the weight of the holder itself (plate 5 appears to be supported by plate 6).

8. Claims 1, 4, 6-8, 19 and 21 are rejected under 35 U.S.C. 102 as being anticipated by Applicant's Admitted Prior Art (pages 1-2 and Fig. 4 of Applicant's specification).

Regarding claim 1, Applicant discloses a device (Fig. 4) for measuring a hard granular object comprising: a measuring vessel (1) having a first face (upper surface of 1), a second face parallel to the first (lower surface of 1) and a space (open portion of 1) for receiving hard granular objects supplied from the first side; a holder (2) on the side of the first face (Fig. 4), having a through hole (Fig. 4) communicable with the space (Fig. 4) and slidable along the first face ([0003]); a shutter (4) located on the side of the second face (Fig. 4), having a through hole communicable with the space (Fig. 4) and movable parallel to the second face ([0003]); and a pressing means for pressing the holder against the measuring vessel (the weight holder 2 on measuring vessel 1; the

phrase "means for pressing" invokes 35 U.S.C. 112, sixth paragraph and Applicant's disclosed means for pressing includes springs, hydraulic forces, pneumatic forces, the weight of the holder and/or magnetic forces; see paragraph 32 of Applicant's specification).

Regarding claims 4 and 6, Applicant discloses part of the first and second faces is made of an abrasion resistant material ([0002], stainless steel).

Regarding claims 7, 8 and 19, Applicant discloses the space of the measuring vessel has an opening with an unchamfered edge in both the first face and the second face (see Fig. 4 which shows the edges of the opening in the measuring vessel 1 are unchamfered).

Regarding claim 21, Applicant discloses the pressing means is the weight of the holder itself (holder 2 appears to be supported by vessel 1).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomelli.

Regarding claim 3, Bonomelli discloses the device of claim 1 (see section 7 above), but does not disclose the holder being pressed against the measuring vessel

with a force smaller than that required to crush the hard granular object. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the force of the holder on the measuring vessel such that the force is less than the force required to crush the object, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

11. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomelli in view of US Patent 3,604,057 to Nixdorff, Jr. (Nixdorff, Jr.).

Regarding claim 2, Bonomelli discloses the device of claim 1 (see section 7 above) but does not disclose a designated gap between the second face and the shutter. Nixdorff, Jr. discloses a device (10) for measuring a hard granular object (granules) comprising a measuring vessel (slide plate 36) having a space (pockets 52 and 54) for receiving hard granular objects supplied from the first side (Fig. 7); a holder (top plate 34) on the side of the first face (Fig. 7), having a through hole (38, 40) communicable with the space (Fig. 7) and slidable along the first face (col. 2, line 62 - col. 3, line 25); a shutter (bottom plate 35) located on the side of the second face (Fig. 7), having a through hole communicable with the space (Fig. 8) and movable parallel to the second face (col. 2, line 62 - col. 3, line 25); and a designated gap kept between the second face and the shutter (col. 2, lines 72-75) to prevent shearing of the product. It would have been obvious to one of ordinary skill at the time of invention to have included a gap between the second face of the measuring vessel and the shutter of the

device of Bonomelli according to the teachings of Nixdorff, Jr. to prevent shearing of the product.

Regarding claim 10, neither Bonomelli nor Nixdorff disclose the holder being pressed against the measuring vessel with a force smaller than that required to crush the hard granular object. It would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the force of the holder on the measuring vessel such that the force is less than the force required to crush the object, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

12. Claims 4-6, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomelli in view of US Patent 6,131,766 to King et al. (King).

Regarding claims 4-6, 12 and 15, Bonomelli discloses the devices of claims 1 and 3 (see section 7 and 10 above), but does not disclose part of the first and second faces being made of an abrasion resistant material and part of the holder being made of acetal resin. Bonomelli is silent as to the material used to make the device. King teaches a dispensing device having sliding parts which are made from acetal resin (a known abrasion resistant material) to prevent wear and oxidation of the parts and to allow for easy cleaning (col. 8, line 64 – col. 9, line 4). It would have been obvious to one of ordinary skill in the art at the time of invention to have formed the holder and faces of the measuring vessel of Bonomelli using acetal resin according to the teachings of King so that the device is wear and oxidation resistant and easy to clean.

13. Claims 11, 13, 14, 16, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomelli in view of Nixdorff, Jr. as applied to claim 2 above, and further in view of King.

Regarding claims 11, 13, 14 and 16, Bonomelli as modified by Nixdorff, Jr. discloses the device of claim 2 (see section 11 above), but does not disclose part of the first and second faces being made of an abrasion resistant material and part of the holder being made of acetal resin. Bonomelli is silent as to the material used to make the device. King teaches a dispensing device having sliding parts which are made from acetal resin (a known abrasion resistant material) to prevent wear and oxidation of the parts and to allow for easy cleaning (col. 8, line 64 – col. 9, line 4). It would have been obvious to one of ordinary skill in the art at the time of invention to have formed the holder and faces of the measuring vessel of Bonomelli using acetal resin according to the teachings of King so that the device is wear and oxidation resistant and easy to clean.

Regarding claims 17, 18 and 20, Bonomelli discloses the space of the measuring vessel has an opening with an unchamfered edge in both the first face and the second face (see Fig. 1 which shows the edges of the opening in the slide plate 6 are unchamfered).

Response to Arguments

14. Applicant's arguments filed March 29, 2010 have been fully considered but they are not persuasive.

a. In response to applicant's argument that Applicant's admitted prior art fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., means for actuating the measuring vessel, means for securing the holder and shutter upon an assembly implementing the configuration and means for connecting the holder to the shutter) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

b. Applicant's other arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

15. Claim 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose nor render obvious a device for measuring a hard granular object including, in combination with the claimed invention as a whole, a spring for pressing the holder against the measuring vessel.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **NICOLAS A. ARNETT** whose telephone number is (571)270-5062. The examiner can normally be reached on Monday - Friday 7:30 AM to 3:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NAA

/Gregory L. Huson/
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